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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/817,149

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David L. Pringle

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EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

MAIL DATE

DELIVERY MODE

08/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,149

Applicant(s)

PRINGLE ET AL.

Examiner

William V. Gilbert

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-34 is/are pending in the application.
- 4a) Of the above claim(s) 5, 13, 26 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-12, 14-25 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 5/29/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a final office action. Claims 1-6 and 8-34 are pending. Claim 7 is cancelled. Claims 5, 13, 26 and 34 are withdrawn from consideration. Claims 1-4, 6, 8-12, 14-25 and 27-33 are examined below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere* Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 6, 8-12, 14-25, 27-30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Han (U.S. Patent No. 5,816,005) in view of Breslow (U.S. Patent No. 3,672,622).

Claim 1: Han discloses a backsplash comprising a layer of tiles (5) having a front surface exposed and resistant to byproducts of work, the layer of tiles are integral and a mount (Fig. 2c: the screws) to releasably engage (by removing the screws) the backsplash to the first surface (Fig. 2c: portion where screw terminates) in at least one location between the backsplash and the first surface, the mount retains the layer of tiles in a perpendicular relationship with respect to a work surface (Abstract: the counter), when the backsplash is in the mounted position on the first surface. The phrase "for protecting a first surface adjacent a work surface substantially perpendicular to the first surface" (preamble) is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Han discloses the claimed invention except for the limitations of the first and second mounts as claimed, where the

first mount is coupled to the second mount to removably couple the backsplash to the first surface. Breslow discloses an apparatus with first and second mounts (Fig. 2: 10, 11) that are removably coupled. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the mount with the panel system in Han because the mount would permit removal of the panel in Han for ease of replacement if damaged while also securing it properly to a surface. Further, the members serve the same function as an attachment means for the panel system.

Claim 2: a support (Han: 3) where the tiles are mounted.

Claim 3: a frame (Han: 1) to receive the support.

Claim 4: the support is a flat panel.

Claim 6: the frame is shaped to receive the layer of tiles.

Claim 8: Han in view of Breslow shows the mounts are shaped to maintain a part of the backsplash against the first surface.

Claim 9: Han in view of Breslow discloses the mounts are releasably coupled by at least one projection (Breslow: 3b) on the first mount received within an aperture (between 3 and 2) of the second mount.

Claims 10 and 12: the first and second mounts (Breslow: 10, 11) are shaped to draw the backsplash to the first surface as the mounts are coupled together.

Claim 11: the first and second mounts are releasably coupled to one another by an upturned flange (3) on one mount and a downturned flange (3b) on the second mount.

Claim 14: tiles are resistant to fluid.

Claim 15: the phrase "dimensioned to be received between the work surface and a range hood..." is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claims 16, 27 and 28: Han discloses a backsplash comprising a layer of protective material (5) having a front surface exposed to and resistant to byproducts. Han does not disclose first and second mounts as claimed. Breslow discloses a first mount mounted (either 10 or 11) to a first surface (7 or article to be attached, 12, which would be the backsplash) and a second mount (11 or 10) coupled to an article to be attached (or the first surface,) which would draw the layer of protective

material, the backsplash, to a flush position against the first surface, and the backsplash would be perpendicular to the work surface (Han: abstract, the counter). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the mount with the panel system in Han because the mount would permit removal of the panel in Han for ease of replacement if damaged while also securing it properly to a surface. Further, per claim 16, the mount is not placed in a recess. It would have been obvious at the time the invention was made to a person having ordinary skill in the art so that the system would be flush with the surface to which it would be attached.

Claim 17: the first and second mounts draw the layer of protective material to the first surface as the mounts are coupled together.

Claim 18: a support (3) where the protective layer is attached.

Claim 19: a frame (1) to receive the support.

Claims 20 and 29: the protective material is tile (20).

Claim 21: the frame is shaped to receive the layer of protective material.

Claims 22 and 32: one mount has an upturned flange (3) that is engageable with a downturned flange (3b) of a second mount.

Claims 23 and 25: the first and second mounts are shaped to draw the backsplash to the first surface as the mounts are coupled together.

Claims 24 and 33: one mount has a projection (3b) that is releasably engageable within an aperture (between 2 and 3) in another of the mounts.

Claim 30: the tiles are resistant to fluid.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Han in view of Breslow as applied to claim 27 above, and further in view of Dills (U.S. Patent No. 3,514,578).

Claim 31: the prior art of record discloses the claimed invention except for positioning the backsplash between the work surface and a range hood located above the work surface. Dills discloses a backsplash (Fig. 1: 19) located between a work surface (10) and a range hood (22). It would have been obvious at the time the invention was made to a person having ordinary skill in the art because backsplashes are well known in the art for preventing damage to walls, and one of ordinary skill in the art would place the backsplash between a range and hood. This

is also obvious because it is further well known in the art to have range hoods over ranges for ventilation.

Response to Arguments

2. The following addresses applicant's remarks dated 18 April 2008:

Claim Objections:

The examiner recognizes applicant's remarks as to the claimed limitations of a "backsplash" and the objection is withdrawn.

35 USC §102 Claim Rejections:

The arguments are moot in light of new grounds for rejection.

35 USC §103 Claim Rejections:

Regarding the applicant's argument that there is not reasoning to combine the prior art of record (Han and Breslow, cited above) to obtain the mounting portion as claimed, the examiner respectfully disagrees. See M.P.E.P. 2144.04 citing *In re Dulberg*, 289 F.2d 522 (CCPA 1961) where the court held that a lipstick holder with a removable cap, was fully met by the prior

art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose." The examiner reasoned in both this office action and the action dated 12 October 2007 that the combination of the prior art of record would permit removal of the panel for ease of replacement if damaged, yet also provide proper attachment to the surface to which it is to be attached.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding the limitation, per claim 16, that the first mount is recess within a rear of the backsplash, please see claim rejection above.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./
Examiner, Art Unit 3635
/Basil Katcheves/
Primary Examiner, Art Unit 3635